

Appl. No. 09/821,230
Amdt. Dated September 3, 2004
Reply to Office Action of June 3, 2004

• • R E M A R K S / A R G U M E N T S • •

The Official Action of June 3, 2004 has been thoroughly studied. Accordingly the following remarks are believed to be sufficient to place the application into condition for allowance.

Claims 1 and 2 are pending in this application.

Claims 1 and 2 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morman.

For the reasons set forth below, it is submitted that each of the pending claims are patentable over the prior art relied upon by the Examiner and therefore, the outstanding rejection of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Morman as:

...describing a composite elastic material which has at least one elastic layer, (which corresponds to the claimed elastically stretchable layer), (column 3, lines 30-33). Morman describes the elastic layer is joined to at least one necked material at least at three locations arranged in a nonlinear configuration (which corresponds to the claimed inelastically stretchable fibrous layer which is bonded orthogonally), (column 3, lines 33-36). Morman describes the composite elastic material has a stretch and recovery in at least one direction, which corresponds to the claimed inelastic fibrous layer in substantially one direction), (column 3, lines 35-52).

Applicants' independent claim 1 requires, in part that the inelastically stretchable layer is formed from continuous fibers and that the continuous fibers are "oriented substantially in one direction."

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The necked material of Morman, which the Examiner construes to be applicants' claimed inelastically stretchable fibrous layer, is described in detail at column 4, lines 44-58. Further description of the necked material can be found at column 7, lines 31-56.

As the Examiner will note, Morman **does not** teach that the necked material is formed from fibers that are continuous and which are oriented substantially in one direction.

On page 2 of the Official Action the Examiner states:

Applicant argues that Morman fails to teach continuous fibers. However, Morman teaches forming the web from a spunbound process, which utilizes continuous fibers (para. 14).

The terms "continuous" and "continuous fibers" are not found in Morman.

The Examiner argues that a spunbound process utilizes continuous fibers.

Whether or not the spunbound process used in Morman forms continuous or discontinuous fibers, it is clear that Morman does not teach fibers that are oriented substantially in one direction as required by applicants' independent claim 1.

The Examiner's attention is directed to Morman at column 2, lines 32-38 whereat Morman states:

As used herein, the term "nonwoven web" means a web that has a structure of individual fibers or threads which are interlaid, but not in an identifiable, repeating manner. Nonwoven webs have been, in the past, formed by a variety of processes such as, for example, meltblowing processes, spunbonding processes and bonded carded web processes. (underlining added)

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Morman expressly teaches away from fibers that are oriented substantially in one direction and instead provides fibers that are not oriented in any identifiable, repeating manner.

That is, the fibers of Morman are laid down in a completely random manner, as is typical when spunbound fibers are allowed to fall freely on a support.

The Examiner has taken the position that:

It would have been obvious....to optimize the stretch efficiency in one direction motivated with the expectation that Morman describes the general conditions of the claimed invention it has been held that discovering optimum value for ranges, corresponding to the stretch efficiency involves only routine skill in this art, *In re Aller*, 105 USPQ 233.

In re Aller the patent claim on appeal was found to encompass a prior art process for treating isopropyl benzene hydroperoxide with sulphuric acid wherein the hydroperoxide is decomposed into phenol and acetone.

The court found that "[t]he process of appellants is identical with that of the prior art, except that applicants' claims specify lower temperatures and higher sulphuric acid concentrations than are shown in the reference."

The court considered arguments submitted by appellants regarding unexpected results which could not be discovered by one skilled in the art.

The court held that appellants' claimed process was merely different in degree and not in kind from the reference process so that criticality of the claimed ranges was not shown.

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The facts and holding of *In re Aller*, are not at all applicable to the present situation in which Morman is not at all concerned with tensile strength ratios. (Note the criticality reviewed by the court in *Aller* involved reaction yields, reactants and products).

In the present case there is no teaching, suggestion or reference to controlling the *alignment* of the fibers of the inelastic layer in Morman to achieve a particular tensile ratio or stretch efficiency. As noted above, Morman expressly teaches away from aligning the fibers along a common direction or orientation, so that it would go against the teachings of Morman to orientate the fibers along a common direction. (See *Ex parte Hartmann*, 186 U.S.P.Q. 366 (PTO Bd App 1977))

Accordingly, the differences between Morman and the present invention do not involve a marginal degree as in the case of *In re Aller*.

Therefore, the Examiner cannot rely upon *In re Aller* as supporting the conclusion that "It would have been obvious....to optimize the ratio of the tensile strengths in the first direction to the second direction."

Morman simple does not teach or suggest the optimization, any benefit or motivation for the optimization, or applicants' particular manner for affecting the tensile strength.

Patentability, as opposed to obviousness, can be found where an invention proceeds contrary to the teachings of the prior art, as in the present case in which Morman teaches against orienting the fibers in a common direction or identifiable, repeating manner.

Based upon the above distinctions between Morman and the present invention, and the overall teachings of Morman, properly considered as a whole, it is respectfully submitted that the

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Examiner cannot rely upon *Morman* as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon *Morman* would be improper inasmuch as *Morman* does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of *Morman* and the outstanding rejections of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

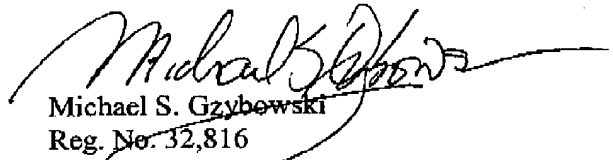
If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

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time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

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